

In re Application of DUTY)

Serial No. 10/635,121)

Filed: August 6, 2003)

Examiner: Tri M. Mai

ART UNIT 3727

For: TOTE BAG WITH A SINGLE STRAP AND POCKETS

RESPONSE TO FINAL OFFICE ACTION OF JUNE 13, 2005

Page 7RemarksIntroduction

This paper responds to the pending FINAL Office Action.

Applicant respectfully submits that the claims define patentable subject matter over the applied references and request the removal of the rejections and issuance of a Notice of Allowability and a Notice of Issue Fee Due.

Rejection of Claims 1-22 under 35 USC §112 ¶2

The Primary Examiner has rejected claims 1-22 as being indefinite because of the use of the word "exclusively". Applicant respectfully disagrees with this rejection.

As an introductory comment, applicant points out that in an opinion dated August 8, 2005, the Federal Circuit in Marley Mouldings Ltd. v. Mikron Ind., Inc., Appeal No. 04-1441 (Fed. Cir. 2005) (Slip Opinion pages 5-6) discussed the definiteness requirement:

The requirement of precision in claiming is codified as follows:

35 U.S.C. §112 ¶2. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The statute is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification. See Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692 (Fed. Cir. 2001) (the definiteness requirement set forth in §112 ¶2 "focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification"); Miles Labs., Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993) (if the claims "reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more"); In re Moore, 439 F.2d 1232, 1235 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a particular area with a reasonable degree of precision and particularity").

The use of the word "exclusively" is intended to point out that it is only the strap that maintains the bags in the rolled up condition. There is no confusion as to what is meant by the claim so that one skilled in the art would "reasonably understand the claim when read in

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the context of the specification". See page 7, lines 1-23 of the present specification.

Applicant thus submits that the claims are not indefinite and respectfully requests the removal of this rejection.

Rejection of Claims 1-3, 7-13, 15 and 16

The Primary Examiner has rejected claims 1-3, 7-13, 15 and 16 as being obvious over Duty in view of either Giugliano or Barnes. Applicant requests the removal of the rejection for the reasons advanced hereinafter.

The pending claims call for the "single strap" to "exclusively maintain": (1) the primary tote bag and secondary tote bag in the rolled up condition [independent claims 1, 17 and 21]; and (2) the primary tote bag about the secondary tote bag [independent claim 9]. The essence of the rejection is that either Giugliano or Barnes addresses the recitation wherein the primary tote bag has a single strap mediate of the handle.

Applicant respectfully submits that Giugliano does not teach a single strap that exclusively maintains the relationship between the primary tote bag and the secondary tote bag as claimed by the amended claims. Instead, Giugliano uses a trio of straps as shown in FIGS. 1 and 2 to secure the bag in a rolled up condition. Applicant respectfully submits that the combination of Duty and Giugliano cannot teach or suggest the invention per the amended claims.

In regard to the rejection based upon the combination of the Duty patent and the Barnes patent, to the extent that Barnes discloses straps, these straps are located on the curling iron carrier. Assuming for the sake of argument that there is any analogous structure between Barnes and the Duty patent, the straps of Barnes are on the secondary bag (i.e., the curling iron carrier) and not on the primary bag (the carrying bag (34)). Applicant thus submits that Barnes cannot modify Duty to address the current invention per the claims under rejection, which require that the single strap is on the primary tote bag.

Applicant respectfully requests the removal of the rejections and the allowance of the claims.

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Page 9Rejection of Claims 4-6, 14 and 17-22

The patent examiner has rejected claims 4-6, 14 and 17-22 as being obvious over Duty in view of either Giugliano or Barnes and in further view of England. Applicant submits that this rejection lacks merit for the reasons set out below.

First, with respect to the combination of Duty in view of either Giugliano or Barnes, applicant reiterates the comments advanced above as to the lack of merit of either grounds of rejection.

Second, applicant submits that there is no teaching or motivation or suggestion to combine England with Duty. England pertains to a V-shaped portfolio that has two rigid panels that fold out to an open position or fold shut to a closed position. Applicant submits that there is no teaching or motivation or suggestion to combine such a structure, i.e., a portfolio with two rigid folding panels with Duty that shows a primary flexible tote bag and at least one secondary flexible tote bag.

Assuming that the combination is proper, applicant submits that England does not supply the pocket that is accessible when the primary tote bag and secondary tote bag are in the rolled up condition. Applicant first point out that the following statement at page 8 of the earlier RESPONSE TO NON-FINAL OFFICE ACTION OF OCTOBER 29, 2004 appears to be in error:

England pertains to a V-shaped portfolio that folds out to an open position or folds shut to a closed position. While England discloses a pocket on the exterior surface of the portfolio, ...

In this regard, a closer look at England shows that FIG. 5 and FIG. 6 appear to represent that the pockets are actually on the interior surfaces of the portfolio when it is in the "closed or carrying position". To better show this feature, an enlarged photocopy of FIGS 5 and 6 is an attachment hereto. As noted on the enlarged copy, the pockets appear to be on the inside when the portfolio is closed for carrying.

With this being the case, England does not address the feature of claim 21, as well as of claims 4-6, 14 and 17-22, that call for the pocket to be accessible when the primary tote bag and secondary tote bag are in the rolled up condition. As can be appreciated, it is an important feature for the pockets to be accessible when the tote bags are rolled up.

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For the above reasons, applicant respectfully submits that claims 4-6, 14, 17-22 define patentable subject matter. Applicant requests the removal of the rejection and the allowance of the claims.

Rejection of Claim 23

The patent examiner has rejected claim 23 as being obvious over Duty in view of either Young et al. or Barman. Applicant submits that claim 23 depends from claim 21 and is patentable for all of the reasons advanced in support of the patentability of claim 21.

Conclusion

Applicant requests that the Examiner enter this paper.

Applicant submits that the claims define patentable subject matter and requests the issuance of a Notice of Allowability and a Notice of Issue Fee Due.

If the patent examiner disagrees with the applicant's arguments, but has suggestions to place the claims in form for allowance, applicant urges the Examiner to telephone the undersigned at 615-662-0100 to discuss such suggestions.

Respectfully submitted

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